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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/022,649	12/17/2001	Francis D. Palazzo	SEDN/4665/5	1815
56/015 7590 06/05/2008 PATTERSON & SHERIDAN, LLP/ SEDNA PATENT SERVICES, LLC 595 SHREWSBURY AVENUE SUITE 100 SHREWSBURY, NJ 07702			EXAMINER SALCT, JASON P	
			ART UNIT 2623	PAPER NUMBER
			MAIL DATE 06/05/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

## Application No.

10/022,649

## Applicant(s)

PALAZZO ET AL.

## Examiner

Jason P. Salce

## Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 16-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SG/US)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/24/2008 has been entered.

### ***Response to Arguments***

Applicant's arguments filed 3/26/2008 have been fully considered but they are not fully persuasive. In regards to claim amendments, the previous 112 1<sup>st</sup> Paragraph rejection regarding those claim amendments are persuasive and the rejection has been rescinded.

Applicant further argues that the specification provides support for the claimed limitations, and further notes that the specification teach "advertisement or other promotional programming is distributed by a content provider (see Page 17, Lines 21-22). Applicant further notes that "advertisements" and "promotional programming" are being introduced as being interchangeably used with respect to Figure 6. The examiner disagrees and notes that the word "or" clearly distinguishes between two separate entities, an advertisement "or" promotional programming. Pages 17-18 further states that when viewing a "promotional", an "advertisement" can be set for recording, again

distinguishing between the two entities (the promotional programming and the advertisement). Figures 5-6 further show examples of recording an advertisement to memory. Figure 5 further supports that an advertisement and promotional programming are separate entities and that when a promotional is selected an advertisement can be selected for recording. Figure 6 again show recording an advertisement while viewing a promotional and because the specification has separately defined the two entities, the examiner cannot assume that these terms can be used interchangeably per the definition of these entities in the specification. For example, a promotional can be an item in the programming event (television show) being viewed in Figure 6 and if the viewer is interested in the promotional, the user can record an advertisement related to the promotional being viewed.

Applicant further argues that earlier portions of the specification teach that EPG actions are available from within the broadcast advertisement. Applicant is further assuming the tense of "the broadcast advertisement". The examiner does not understand how the tense of the term "the broadcast advertisement" can be determined from the present description in Applicant's specification. The broadcast advertisement can still be an advertisement displayed to the viewer at any point in time and not necessarily as the viewer is actually viewing the advertisement, but instead viewing a promotional, as taught by Figures 5-6. Further, noting that EPG actions are available from within the broadcast advertisement only states that a viewer can perform EPG options by accessing the metadata instructions received within the advertisement.

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Nowhere does the specification teach that while viewing an advertisement, a viewer can record the advertisement while currently viewing the advertisement.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 16-32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Referring to independent claims 16-32, the claims recite the limitations, "presenting the interactive advertisement, the interactive advertisement including a selectable option for the user to store the interactive advertisement on a user-defined storage device for future viewing, during presentation of the interactive advertisement". The examiner notes that this is in direct contradiction with what is taught by the specification.

Note Figure 6, Page 3, Lines 9-15 and Pages 17-18 where the interactive advertisement is only recorded if the interactive advertisement is not presently playing. For example, if the interactive advertisement is currently playing, the channel will be force tuned to the channel playing the interactive advertisement (not recorded),

therefore the claim could never be supported by the specification where an interactive advertisement is recorded while it is currently playing. Specifically note Page 3, Lines 9-15, where the specification specifically states, ***"The video window contains promotional programming such as an advertisement for a sports event or movie, whether presently playing or scheduled to be broadcast at a future time/or date. By selecting the video window, the viewer may view expanded information about the event and, if desired, be AUTOMATICALLY OR FORCE TUNED TO THE PROGRAM BEING PROMOTED"***. The specification separately teaches, ***"If the event being promoted is to be aired IN THE FUTURE, THE VIEWER IS DIRECTED TO DIALOGS FOR SETTING A PROGRAM REMINDER OR TO PROGRAM A VIDEO RECORDING DEVICE"***. Therefore, the specification teaches away from what is claimed. The only time a program is reserved for a recording is when it is to be broadcast in the future, therefore an actual recording cannot be performed during presentation of the interactive advertisement. Also note Figure 6 and Pages 17-18 where the viewer is viewing a **"promotional"** and further access the **"promotional"** to record an **"advertisement"**, clearly the specification distinguishes between what is viewed and what is being recorded in addition to the specification to specifically teaching recording while the advertisement is currently being presented.

In regards to the previous 112 1<sup>st</sup> Paragraph rejection, Applicant further notes that Pages 10 and 11 support the claimed limitations. Applicant states, "One of the EPG actions available from within the advertisement may be storing the advertisement (i.e. the advertisement being presented)". The examiner notes that the example given

by the Applicant is stated nowhere in these portions of the specification. The specification does not clearly distinguish between an advertisement currently being displayed or displayed at a future time. Applicant further notes that Figure 6 further provides support for Pages 10 and 11 of the specification, however Figure 6 is explained in detail on Pages 17 and 18 of Applicant's specification. As stated on Pages 17-18, the advertisement that is to be recorded is clearly distinguished from the "promotional" being displayed. This is further supported by Figure 5 of the specification. Therefore, Applicant's own specification actually supports that the advertisement being recorded is separate from the "promotional" advertisement being displayed. Therefore, Applicant's specification does not clearly disclose recording an advertisement during presentation of the advertisement.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason P. Salce whose telephone number is (571) 272-7301. The examiner can normally be reached on M-F 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jason P Salce/  
Primary Examiner, Art Unit 2623

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Primary Examiner  
Art Unit 2623

May 31, 2008